

REMARKS

Claims 1-7 are currently pending in the present application.

Claim 1 is the only independent claim. Claim 1 has been amended to more clearly point out that the fabric protectant comprises an ester compound of formula (1) and 2,4,6-triisopropyl-1,3,5-trioxane, and that the ester compound and 2,4,6-triisopropyl-1,3,5-trioxane are enveloped in a film. Support for the claim amendments is found at least from original claim 1 and Production Examples 1-14 of the specification. The amendments do not add any new matter to the application, entry of the amendments is respectfully requested.

The Examiner has grouped the application into two genii: Genus I contains three species, claims 2-4, directed at three different compositions for the films; Genus II contains two species, claims 6 and 7, directed at two different ester compounds. Claim 1 is generic.

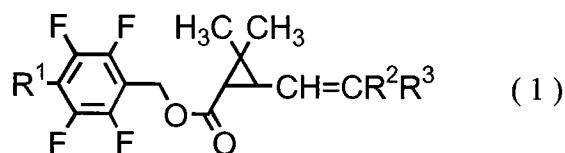
Applicants hereby affirm the provisional election, made during a telephone conversation on June 20, 2007, of species Ia and IIa, thus claims 1, 2, 5 and 6, for prosecution on the merits. Claims 3, 4 and 7 have been withdrawn from further consideration as being drawn to a nonelected invention.

Claim Rejections Under 35 U.S.C. §102

The Examiner has rejected claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by Sugano (EP 962140) ("Sugano").

Sugano does not anticipate claims 1 and 2, because Sugano does not disclose an ester compound of formula (1). Sugano describes a fabric protectant comprising 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(2-chloro-2-fluorovinyl)-2,2-dimethylcyclopropanecarboxylate as an active ingredient.

The fabric protectant of the present claims comprising an ester compound given by formula (1):



wherein R^1 represents a hydrogen atom, methyl group, methoxy group or methoxymethyl group; and R^2 and R^3 independently represent a chlorine atom, hydrogen atom or methyl group, but not a fluorine atom. Therefore, an ester compound given by formula (1) does not include 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(2-chloro-2-fluorovinyl)-2,2-dimethylcyclopropanecarboxylate disclosed in Sugano. Thus, Sugano does not anticipate claims 1 and 2.

Sugano does not anticipate claims 1 and 2 further because Sugano does not disclose a fabric protectant enveloped in a film selected from those recited in claim 1. The Examiner has asserted that “although the claims recite that the fabric protectant is enveloped in a film, the current claims are not to the film, but to the fabric protectant itself.” Claim 1 is amended to more particularly point out that the claimed fabric protectant is enveloped in a film, i.e., by reciting that “wherein the ester compound and 2,4,6-triisopropyl-1,3,5-trioxane are enveloped in a film selected from the group consisting of polyethylene having 0.91 to 0.94 g/cm³ of density, copolymer of ethylene and vinyl acetate, and copolymer of ethylene and methyl metacrylate.”

The determination of whether a “wherein” clause in a claim is material to patentability depends on the specific facts of the case, see MPEP 2111.04. Applicants respectfully submit that the “wherein” clause in claim 1 is material and should not be ignored for patentability determination, at least because the envelop of the present application provides advantage over the prior art. As discussed in the Background Art of the present application, although fabric protectant is generally used in a package for preventing damages of fabric, the effect of fabric protectant may decrease by absorption of the active ingredient in the fabric protectant into the envelope. The present application teaches, e.g., by comparative tests in Test Example 4, that the envelop of the present application did not decrease the fabric protection effect of the present fabric protectant, rather it increased the fabric protection effect at early stage, see Table 4. Therefore, in order to anticipate the present claims, the prior art reference must not only disclose a fabric protectant comprising an ester compound of formula (1) and 2,4,6-triisopropyl-1,3,5-

trioxane, but also disclose that the fabric protectant is enveloped in a film selected from those recited in claim 1.

Although Sugano discloses a mixture of 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(2-chloro-2-fluorovinyl)-2,2-dimethylcyclopropanecarboxylate and 2,4,6-triisopropyl-1,3,5-trioxane in a plastic container (e.g., polyethylene), it does not teach or suggest a fabric protectant enveloped in a film selected from those recited in claim 1.

Accordingly, Sugano does not anticipate claims 1 and 2. Reconsideration and withdrawal of the rejection of claims 1 and 2 under 35 U.S.C. §102(b) as being anticipated by Sugano are respectfully requested.

The Examiner has rejected claims 1, 2 and 5 under 35 U.S.C. §102(b) as being anticipated by Aoki (JP2000355510) ("Aoki").

Aoki does not anticipate claims 1, 2 and 5, at least because Aoki does not disclose a fabric protectant enveloped in a film. As discussed above, in order to anticipate the present claims, the prior art reference must not only disclose a fabric protectant comprising an ester compound of formula (1) and 2,4,6-triisopropyl-1,3,5-trioxane, but also disclose that the fabric protectant is enveloped in a film selected from those recited in claim 1. Aoki discloses that an active ingredient, such as 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(2,2-dichlorovinyl)-2,2-dimethylcyclopropanecarboxylate, can be mixed with a sublimable compound, such as 2,4,6-triisopropyl-1,3,5-trioxane, see paragraph [0016]. At most, Aoki suggests a sublimable formulation comprising the active ingredient and 2,4,6-triisopropyl-1,3,5-trioxane. It does not teach or suggest that a fabric protectant enveloped in a film selected from those recited in claim 1.

Accordingly, Aoki does not anticipate claims 1, 2 and 5. Reconsideration and withdrawal of the rejection of claims 1, 2 and 5 under 35 U.S.C. §102(b) as being anticipated by Aoki are respectfully requested.

The Examiner has also rejected claims 1, 2, 5 and 6 under 35 U.S.C. §102(a) as being anticipated by Tsushima (US 2005/0137250) ("Tsushima").

Tsushima does not disclose a fabric protectant enveloped in a film selected from those recited in claim 1. For reasons discussed above under Aoki, Tsushima does not anticipate claims 1, 2, 5 and 6. Reconsideration and withdrawal of the rejection of claims 1, 2, 5 and 6 under 35 U.S.C. §102(a) as being anticipated by Tsushima are respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected claims 5 and 6 under 35 U.S.C. §103(a) as being unpatentable over Sugano in combination with Tsushima or Takagawa et al. (JP 2002320544) ("Takagawa"). The Examiner concedes that Sugano does not exemplify 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethylcyclopropanecarboxylate as the pyrethroid ester compound. However, the Examiner asserts that it is known in the art to use 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethylcyclopropanecarboxylate as a species of the genus pyrethroid ester fabric protectant in insecticide formulations, such as taught by Tsushima or Takagawa. The Examiner further asserts that the species of genus is prima facie obvious, and that it is applicants' burden to establish that species or sub-species provides some unexpected results over the applied references.

Sugano and Tsushima are discussed above. Sugano and Tsushima fail to render claim 1, and its dependent claims, such as claims 5 and 6, prima facie obvious, at least because the references, alone or in combination, fail to disclose or suggest a fabric protectant enveloped in a film selected from those recited in claim 1. Reconsideration and withdrawal of the rejection of claims 5 and 6 under 35 U.S.C. §103(a) as being obvious over Sugano in view of Tsushima are respectfully requested.

Takagawa fails to compensate for the defects of Sugano. Takagawa directs to a mothproof cover for clothing, which comprises a front sheet of plastics and a back sheet of a nonwoven fabric containing volatile pyrethroids and nonvolatile insecticides. Although Takagawa discloses 2,3,5,6-tetrafluoro-4-methylbenzyl 3-(1-propenyl)-2,2-dimethylcyclopropanecarboxylate as an insecticide, it does not disclose 2,4,6-triisopropyl-1,3,5-trioxane. Takagawa does not teach or suggest to combine the insecticide with a sublime compound such as 2,4,6-triisopropyl-1,3,5-trioxane in a fabric protectant. Furthermore,

Takagawa does not teach or suggest a fabric protectant enveloped in a film selected from those recited in claim 1.

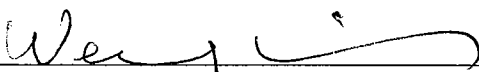
Accordingly, Sugano in combination with Takagawa does not render claim 1, and its dependent claims, such as claims 5 and 6, prima facie obvious. Reconsideration and withdrawal of the rejection of claims 5 and 6 under 35 U.S.C. §103(a) as being obvious over Sugano in view of Takagawa are respectfully requested.

For reasons discussed above, claim 1 and its dependent claims 2, 5 and 6 are not anticipated or rendered obvious by the cited prior art references, alone or in combination, thus are allowable. The Examiner has pointed out that claim 1 is generic to genii I and II. Upon the allowance of the generic claim 1, Applicants respectfully request rejoinder of additional species claims 3, 4 and 7 for examination on the merits. Because claims 3, 4 and 7 depend from or otherwise require all the limitations of the allowable generic claim 1, Applicants respectfully submit that claims 3, 4 and 7 are also allowable in view of the above discussions.

It is respectfully submitted that the present application, including currently pending claims 1-7, is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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